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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,274	10/17/2001	Ryan Lance Levin	1-15562	8186

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EXAMINER

COBANOGU, DILEK B

ART UNIT	PAPER NUMBER
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3626

MAIL DATE	DELIVERY MODE
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08/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/982,274

Applicant(s)

LEVIN ET AL.

Examiner

Dilek B. Cobanoglu

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 14-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Request for Continued Examination (RCE) filed on 05/29/2007. Claims 11 and 13 have been canceled. Claims 1-10, 12, 14-15 remain pending in the application.

Specification

2. The amendment filed 05/29/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "receiving a premium or contribution payment from the members of the medical insurance scheme". In particular, Applicant does not point to, nor was the Examiner able to find, any support for "receiving a premium or contribution payment from the members of the medical insurance scheme" within the specification as originally filed. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

3. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "receiving a premium or contribution payment from the members of the medical insurance scheme" was not described in the originally filed specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claim 1 recites the limitation "receiving a premium or contribution payment from the members of the medical insurance scheme" in the lines 3-4. There is no description or recitation about this limitation in the originally filed specification. It is not clear if the premium or contribution payment is for insurance coverage or for the usage of the relevant health services and/or assistance in defraying expenses incurred in connection with rendering such relevant services.

8. Claim 14 still depends on the canceled claim 13, and claim 14 recites "the provider offering services and monitoring the use of the services". There is insufficient antecedent basis for this limitation in the claim. The independent claim 1 does not recite who is offering the health related facilities and services.

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9. Claim 15 recites that "members only pay a once off activation fee to gain access to the plurality of health related facilities and/or services". It is not clear what kind of fee and/or premium member has to pay; is it the premium or contribution of payment for the insurance coverage, or activation fee for plurality of health related facilities and/or services or both. Since the newly added limitation of claim 1 recites that "member paying a premium or contribution of payment of the medical insurance scheme", and there is no description or recitation about this limitation in the specification, it's not clear what kind of premium or fee the member pays and for which service.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

NOTE: The following rejections assume that the subject matter added in 05/29/2007 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 2-3 above in the next communication sent in response to the present Office Action.

11. Claims 1-10 and 14-15 are rejected under 35 U.S.C. 102(e) as being unpatentable by Douglas et al. (U.S. Patent No. 6,039,688).

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A. Claim 1 has been amended now to recite a method of managing the use of a medical insurance scheme by members thereof including:

- i. receiving a premium or contribution payment from members of the medical insurance scheme (Douglas; col. 2, lines 9-22, col. 5, lines 28-34);

Examiner considers that the subscriber of the system would pay a premium, a contribution payment or a fee to be a subscriber or a member.

- ii. providing to members who pay such premiums or make such contributions, relevant health services, and/or assistance in defraying expenses incurred in connection with rendering such relevant health services (Douglas; col. 2, lines 9-22, col. 6, lines 27-48);

- iii. defining a plurality of health-related facilities and/or services (Douglas et al.; col. 6, lines 7-13);

- iv. offering the facilities and/or services to members of the medical aid scheme (Douglas et al.; col. 6, lines 27-38);

- v. monitoring use of the facilities and/or services by each member (Douglas et al.; col. 7, lines 54-65 and col. 10, lines 9-16);

- vi. allocating a credit value to each member according to their use of the facilities and/or services (Douglas et al.; col. 14, lines 38-42); and

- vii. allocating rewards to members who accumulate credit values exceeding predetermined values (Douglas et al.; col. 14, lines 42-47).

B. As per claim 2, Douglas et al. discloses a method according to claim 1 wherein the plurality of health-related facilities and/or services includes at least one of the group consisting of membership of health clubs, membership of gymnasiums, membership of fitness programs, weight loss programs and programs to quit smoking (Douglas et al.; col. 5, line 60 to col. 6, line 6).

C. As per claim 3, Douglas et al. discloses a method according to claim 2 wherein the plurality of health-related facilities and/or services further includes predetermined preventive medical procedures (Douglas et al.; col. 2, lines 23-47).

D. As per claim 4, Douglas et al. discloses a method according to claim 2 wherein the plurality of health-related facilities and/or services further includes a medical advice service (Douglas et al.; col. 14, lines 46-52 and col. 15, lines 1-4).

E. As per claim 5, Douglas et al. discloses a method according to claim 2 wherein the plurality of health-related facilities and/or services further includes predetermined procedures (Douglas et al.; col. 15, lines 25-39).

F. As per claim 6, Douglas et al. discloses a method according to claim 5 wherein the predetermined procedures include at least one of the group consisting of advance pre-authorization of hospitalization, advance pre-authorization of treatment, registration for electronic funds transfer and compliance with preferred procedures (Douglas et al.; col. 5, lines 45-51).

G. As per claim 7, Douglas et al. discloses a method according to claim 1 wherein a reward allocated to a member is linked to the amount of the member's

annual claims or whether or not the member has been hospitalized in a predetermined period of time (Douglas et al.; col. 14, lines 38-42 and col. 17, line 64 to col. 18, line 5).

H. As per claim 8, Douglas et al. discloses a method according to claim 7 wherein the reward allocated to the member includes at least one of the group consisting of: prizes allocated on the basis of a draw, the magnitude of a member's credit value being related to the chance of winning the draw; access to health-related facilities and/or services for family members; decreased premium payments according to a predetermined scheme; and increased benefit payments according to a predetermined scheme (Douglas et al.; col. 5, lines 52-59).

I. As per claim 9, Douglas et al. discloses a method according to claim 1 wherein a reward allocated to a member is not actually given to the member before a predetermined period has passed or the member has attained a predetermined age (Douglas et al.; col. 18, line 66 to col.19, line 2).

J. As per claim 10, Douglas et al. discloses a method according to claim 9 wherein the reward allocated is forfeited by the member if they are not still a member of the medical aid scheme after the predetermined period has passed or after the member has attained such predetermined age (Douglas et al.; col. 14, lines 38-47).

K. As per claim 14, Douglas discloses a method according to claim 1, including:

- i. The provider offering the facilities and/or services in conjunction with third party service providers (or case advisors) that provide health related facilities and/or services (Douglas; col. 5, lines 28-38);
- ii. Monitoring the use of the facilities and/or services by members by receiving information from the third party service providers (or case advisors) detailing the use of the health related facilities and/or services by the members (Douglas; col. 6, lines 2-6, Fig. 1).

Examiner considers that claim 14 is depending on independent claim 1, since claim 13 has been canceled, and Applicant has not amend claim 14.

L. As per claim 15, Douglas discloses a method according to claim 14, wherein the members only pay a once off activation fee to gain access to the plurality of health related facilities and/or services (Douglas; col. 2, lines 9-22).

Examiner considers that the subscriber of this system would pay a activation fee to be a subscriber.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. (hereinafter Douglas) (U.S. Patent No. 6,039,688) in view of Ballantyne et al. (hereinafter Ballantyne) (U.S. Patent No. 5,867,821).

A. As per claim 12, Douglas discloses the method according to claim 3.

Douglas fails to expressly teach the vaccination information. However, this feature is well known in the art, as evidenced by Ballantyne.

In particular, Ballantyne discloses vaccination information (Ballantyne; col. 15, lines 41-47).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Ballantyne with the motivation of enhancing healthcare quality (Ballantyne; col. 2, lines 55-62).

Response to Arguments

14. Applicant's arguments filed 05/29/2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear.

A. In response to Applicant's argument about Douglas does not disclose the actual offering of health-related facilities and/or services to the individual, as is claimed in claims 1 and 10 of this application, Examiner respectfully submits that Douglas discloses health-related services for members of the medical scheme such as a service for losing weight or an online support group to help them

achieve their health and wellness goals (Douglas; col. 5, line 65 to col. 6, line 6 and col. 6, lines 28-48). As can be seen in Figure 1 and col. 5, lines 28-34, the patient's (or the member's) medical insurance scheme is part of this system.

B. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., provider of such medical scheme undertakes liability in return for a premium or contribution, and provides to members who pay such premiums or make such contributions, relevant health services, and/or assistance in defraying expenses incurred in connection with rendering such relevant health services) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

C. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., managing the use of a medical scheme by members) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach "Computer directed

exercising apparatus" 4,556,216 A, "System for skip rope exercising" 4,699,375 A, "Fitness and nutrition game apparatus and method of play" 5,062,645 A, "Character thinning using emergent behavior of populations of competitive locally independent processes" 5,574,803 A, "Fitness feedback system for weight stack machines" 5,655,997 A, "Process and system for arrangement of documents" 5,745,893 A, All care health management system 5,301,105 A, Computerized healthcare accounts receivable purchasing collections securitization and management system 5,550,734 A, Behavior prediction for rule-based data processing apparatus 5,832,467 A.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 3626
08/01/2007


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